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OFFICE OF PETITIONS

In re Application of
Vincent J. Contini, et al.
Application No. 10/809,331
Filed: March 26, 2004
Attorney Docket No. CON002-059

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 15, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned in view of a letter of express abandonment filed November 1, 2006, which is signed by a registered patent attorney or record.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D).

The petition is not found to comply with any of the requirements of 37 CFR 1.137(b).

It is noted that petitioner indicates that the letter of abandonment was filed in the wrong application. Petitioner does not provide any evidence to support this claim. However, MPEP 711.01 clearly warns that "[i]t is imperative that the attorney or agent of record exercise every precaution in ascertaining that the abandonment of the application is in accordance with the

desires and best interests of the applicant prior to signing a letter of express abandonment of a patent application. Moreover, special care should be taken to ensure that the appropriate application is correctly identified in the letter of abandonment.”

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

There was no response period running against this application, which resulted in the abandonment of the application. The abandonment in this case resulted solely from a deliberate course of action by applicant's duly appointed representative and the abandonment was properly acknowledged by the Office. Consequently, there is a heavy burden of proof on petitioner to revive this application under the provisions of 37 CFR 1.137(b).

Petitioner states that the letter of express abandonment was filed in the wrong application. The statement is considered speculative since it does not come from someone having first hand knowledge of the filing. Statements are required from any and all person(s) having firsthand knowledge of the circumstances of the filing of the letter of express abandonment, i.e., Attorney Kirk W. Goodwin, and how the error in identifying this application for express abandonment occurred. In addition, it is necessary to establish what factors were considered in the decision making process to maintain this case or not. Any correspondence discussing the prosecution strategy to abandoned the application or maintain it in force between the firm and the client is required. Any documentary evidence demonstrating the circumstances surrounding the filing of the letter of express abandonment must also be provided.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
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By hand: U. S. Patent and Trademark Office
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401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300**.

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO. In this case, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley

Sherry D. Brinkley
Petitions Examiner
Office of Petitions